

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/298,160 04/22/99 CLUSTER

D MI22-1172

021567 IM22/1022
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SPOKANE WA 99201-3828

 EXAMINER

OLSEN, A

ART UNIT	PAPER NUMBER
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1746

DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/298,160	Applicant(s) Custer et al.	Examiner Allan Olsen	Art Unit 1746	
	-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --				
Period for Reply <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 					
Status <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug 7, 2001</u></p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>					
Disposition of Claims <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1 and 3-5</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1 and 3-5</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>					
Application Papers <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>					
Priority under 35 U.S.C. § 119 <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <p>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>					
<p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>					
Attachment(s) <p>15) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>20) <input type="checkbox"/> Other: _____</p>					

DETAILED ACTION

Withdrawal of Claim Rejections

1. In view of the amendment filed 8/7/01 the rejection under 35 U.S.C. 112, second paragraph, of claims 1 and 3-5 is withdrawn.
2. The rejection under 35 U.S.C. 102(e) of claims 1 and 3-5 as being anticipated by Sakurai et al. is withdrawn because applicant's priority date precedes both the US filing date and the publication date of the priority documents.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371C of this title before the invention thereof by the applicant for patent.

3. **Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen et al. (US 5,800,626).**

Cohen teaches a method of preparing an aqueous liquid for use in a semiconductor wafer fabrication process. Cohens teaches first degassifying, then regassifying, the aqueous liquid so that the dissolved gas content is greater than 200 ppb. While Cohen does not teach using the regassified liquid in a polishing process, the examiner notes that Claim 1 is positively recited as a method of preparing a liquid. Claim 1 twice refers to a polishing process. However, each reference is merely a statement of a future intended use and such statements are given little patentable weight. Specifically, this limitation is considered to the extent that a prior art solution,

having been prepared by the method of claim 1, need only be capable of being used in the claimed future intended use in order for that prior art to be considered anticipatory. Cohen's aqueous solution is made in the manner of claim 1 and it is certainly capable of being used in a wet-etch, semiconductor polishing process. Therefore, Cohen teaches each and every limitation of claims 1 and 3-5. See: figure 1; col. 5, lns 5-15; col. 7, lns 40-43; col. 3, lns 59-60.

4. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Yeol et al. (US 6,039,815).

Yeol teaches a method of preparing a liquid by first degassifying the liquid and then regassifying the liquid so that the dissolved gas content is greater than 200 ppb. While Yeol does not teach using the regassified liquid in a polishing process, the examiner notes that Claim 1 is positively recited as a method of preparing a liquid. Claim 1 twice refers to a polishing process. However, each reference is merely a statement of a future intended use of the liquid prepared by the method of claim 1. Statements of future intended use are given little patentable weight. Specifically, this limitation is considered to the extent that a prior art solution need only be capable of being used in the claimed future intended use. Yeol's aqueous solution is made in the manner of claim 1 and it is certainly capable of being used in a wet-etch, semiconductor polishing process. Therefore, Yeol teaches each and every limitation of claims 1 and 3-5. See: col. 5, lns 12-27; col. 6, lns 41-42; col. 7, lns 26, 42, 64.

Response to Amendment

5. The amendment filed 8/7/2001 (filed in response to the Office action of 12/15/2000) positively recited using the regassified liquid. While this prompted a rejection based on 35 U.S.C. 112, it also caused the examiner to withdraw the 102 rejections of claim 1 based upon the teachings of Cohen and Yeol. The amendment filed 8/7/01 deleted the "use" limitations. Therefore, the 112 rejection has been withdrawn. Likewise, as claim 1 now lacks the positive recitation of using the regassified liquid in a particular manner, the previous 102 rejection of claim 1 over each of Cohen and Yeol are now reinstated. Claims 3-5 are additionally rejected.

Response to Arguments

6. Applicant's arguments filed 08/07/2001 have been fully considered but they are not persuasive. Applicant argues that Cohen and Yeol do not teach preparing a solution that is for use in a polishing process. The instant claims are directed to a method of preparing a liquid. They are not directed to the method in which the solutions are used. Applicant's position has steadfastly focused on the manner in which the liquid is used. Applicant has already received several patents on methods of using liquids prepared by the method of claim 1. The instant claims however are directed to a method of preparing a liquid and this instantly claimed method is one that has been anticipated by each of Cohen and Yeol.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Olsen whose telephone number is (703) 306-9075. The examiner can normally be reached on Monday through Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (703) 308-4333. The fax phone number for this Group is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Allan Olsen, Ph.D.
October 12, 2001

Allan A. Olsen
PATENT EXAMINER
AU. 1746